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REMARKS

Claims 1, 7 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crisp in view of Johnson et al.. This rejection is respectfully traversed for the following reasons.

The Examiner has relied on newly cited Johnson et al. as allegedly disclosing "wherein said radio control circuit section changes a responding method for responding to an incoming call ... to an automatic responding method that requires no operation." However, Johnson et al. discloses only that "the call may be answered merely by displacing the cover 2" (*see* paragraph [0038], lines 7-8). Accordingly, in response to an incoming call, the cover 2 must be *manually* displaced to answer the call. The Examiner has apparently interpreted the act of opening the flip-lid as the automatic responding method. In order to clarify the distinction between the present invention and cited prior art, the last line of claims 1 and 9 have been amended to define:

-- ... when the movable-lid is determined to be in an opened state....--.

The amendment emphasizes that the act of opening the lid is not the automatic responding method. Rather, the lid *being* in an opened state (either during the opening of the lid or after the lid has already been opened) changes the manual responding method to an automatic responding method. Accordingly, once the telephone apparatus is in the automatic responding method resulting from the lid being in an opened state, thereafter, an incoming call could be automatically answered. In short, the automatic responding method embodies automatically answering an incoming call *because* the lid is in an opened state rather than *in response* to an act of opening the lid.

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The Examiner is directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claims 1 and 9 as amended because the proposed combination fails the "all the claim limitations" standard required under § 103.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1 and 9 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

For example, with respect to claims 6 and 14 (as well as new claims 17 and 18), the Examiner admits that Crisp does not disclose a timer and therefore relies on Ulveland. However, it is respectfully submitted that Ulveland does not overcome the deficiencies of Crisp with respect to claim 6. Ulveland merely discloses at col. 2, lines 1-5:

In a second embodiments, the cover is moveable between two positions – open and closed. The automatic answer feature of the phone is not activated immediately when the cover is opened. Instead the phone waits a predetermined period of time before accepting the incoming call. Thus, the telephone gives the user an allotted amount of time,

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referred to as the preview period, to view the caller ID information and decide whether to answer the call.

That is, the telephone of Ulveland does NOT respond to any incoming call during a predetermined period of time. The Examiner reads the answer delay time taught by Ulveland for previewing a call before answering it, as equivalent to the claimed timer/process. However, the timer/process of the present invention can *release* the *changed* responding method so as to enable, for example, return to the original responding method. Accordingly, the present invention can allow the default responding method to be automatically reset after it was changed in response to the detected result (e.g., flip-lid, antenna, etc.).

In contrast, Ulveland simply discloses providing a delay *before activating* an original responding method (which has never been changed or released). The delay of Ulveland thereby serves to pause the response rather than change the responding method. As such, it is respectfully submitted that the time delay of Ulveland is unrelated to the timer/process of the present invention.

Based on all the foregoing, it is submitted that claims 1, 7 and 9 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection of claims 1, 7 and 9 under 35 U.S.C. § 103 be withdrawn. Further, new claims 17 and 18 each define a timer and are therefore submitted to be patentable over the cited prior art for at least reasons similar to those discussed above regarding claims 6 and 14 with respect to Ulveland.

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Claims 2 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crisp in view of Phillips, claims 3, 8 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crisp in view of Johnson and Paterson, claims 4 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crisp in view of Phillips and Paterson, claims 5 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crisp in view of Paterson and Phillips, and claims 6 and 14-16 stand rejected under 35 U.S.C. § 103 over Crisp in view of Johnson and Ulveland. These rejections are respectfully traversed for the following reasons.

Other than replacing Kim with Johnson et al., the Examiner's grounds of rejection are the same as previously set forth in the Office Action dated March 14, 2003. Indeed, the Examiner's position with respect to the distinctive features of claims 2-6, 8 and 10-16 has not changed and is independent of Johnson et al.. Moreover, the Examiner has not responded to the detailed arguments Applicants set forth in the amendment filed on June 9, 2003, so it is unclear why the Examiner has maintained the same position. Applicants submitted detailed arguments for the patentability of each of the remaining claims on pages 8-14 of the amendment filed on June 9, 2003. Accordingly, without a new rejection or response to the arguments from the Examiner, it is respectfully submitted that the deficiencies of the pending rejections as previously argued in the amendment filed June 9, 2003 are still a valid basis for the patentability of those claims.

Accordingly, the rejection of claims 2-6, 8 and 10-16 is respectfully traversed based on the previously filed arguments. The Examiner is directed to MPEP § 707.07(f) under the heading "Answer All Material Traversed", which sets forth the applicable requirement: "[w]here the applicant traverses any rejection, the examiner should, if he or

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she repeats the rejection, take note of the applicant's argument and answer the substance of it." For the Examiner's convenience, the arguments for the patentability of claims 2-6, 8 and 10-16 are reprinted below. If the Examiner maintains any one or more of the pending rejections, it is respectfully requested that the Examiner please respond to those arguments submitted against any maintained rejection.

### III. CLAIMS 2 AND 10 ARE PATENTABLE OVER CRISP IN VIEW OF PHILLIPS

Claims 2 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crisp in view of Phillips. This rejection is respectfully traversed for the following reasons. The Examiner admits that Crisp does not disclose an antenna state detecting circuit and therefore relies on Phillips to modify Crisp in an attempt to reach the claimed invention. However, with respect to Phillips, it is respectfully submitted that the antenna position sensing circuitry is used to activate or deactivate the functionality of the phone rather than *change the responding method*.

For example, although it appears that extending the antenna can be used to automatically answer the phone (*see* col. 4, lines 1-7; col. 6, lines 55-58), such operation does not *change* one responding method to another but rather, merely *activates* a single responding method. It is respectfully submitted that the inactive state of Phillips when the antenna is not extended can not reasonably be interpreted as a responding method, so that activation thereof would NOT be a change in a responding method.

In order to clarify this distinction, claims 2 and 10 have been amended to define changing from a first responding method to a second responding method, whereas the inactive state of Phillips is a NON-responding method rather than a first/second responding method.

The Examiner is again directed to MPEP § 2143.03 under the section entitled "All Claim Limitations Must Be Taught or Suggested", which sets forth the applicable standard:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)).

In the instant case, the pending rejection does not "establish *prima facie* obviousness of [the] claimed invention" as recited in claims 2 and 10 as

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amended because the proposed combination fails the "all the claim limitations" standard required under § 103.

Based on all the foregoing, it is submitted that claims 2 and 10 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection of claims 2 and 10 under 35 U.S.C. § 103 over Crisp in view of Phillips be withdrawn.

#### IV. CLAIMS 3 AND 11 ARE PATENTABLE OVER CRISP IN VIEW OF KIM AND PATERSON

Claims 3 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crisp in view of Kim and Paterson. This rejection is respectfully traversed for the following reasons.

The Examiner admits that Crisp/Kim does not disclose a plug and therefore relies on Paterson to modify Crisp in an attempt to reach the claimed invention. However, even assuming *arguendo* that using a flip-lid state detecting circuit and plug detecting circuit are *individually* known, the cited prior art does not suggest the *combination* thereof. Claims 3 and 11 embody changing the responding method when "opening the flip-lid *and* [(rather than OR)] putting the plug are determined" so that the claims expressly define a functional interrelationship between the states of the flip-lid and plug. As the Examiner relies on separate references for allegedly disclosing the structurally distinct flip-lid and plug detecting circuits individually, even assuming the proposed combination is proper, no such functional interrelationship is suggested by the cited prior art.

It is submitted that the proposed combination is improper because the Examiner has not provided the requisite *objective* evidence *from the prior art* that "suggests the desirability" of the proposed combination. As is well known in patent law, a *prima facie* showing of obviousness can only be established if the prior art "suggests the desirability" of the proposed combination using objective evidence. The Examiner is directed to MPEP § 2143.01 under the subsection entitled "Fact that References Can Be Combined or Modified is Not Sufficient to Establish *Prima Facie* Obviousness", which sets forth the applicable standard:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (*In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990)).

In the instant case, even assuming *arguendo* that Crisp can be modified by Paterson, it is submitted that the "mere fact that [Crisp and Paterson] can be combined ... does not render the resultant combination obvious"

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because nowhere does the *prior art* "suggest the desirability of the combination" as set forth by the Examiner.

The Examiner is further directed to MPEP § 2143.01 under the subsection entitled "Fact that the Claimed Invention is Within the Capabilities of One of Ordinary Skill in the Art is Not Sufficient by Itself to Establish *Prima Facie* Obviousness", which sets forth the applicable standard:

A statement that modifications of the prior art to meet the claimed invention would have been [obvious] because the references relied upon teach that all aspects of the claimed invention were *individually* known in the art is *not* sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. (citing *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)).

In the instant case, even assuming *arguendo* that Crisp and Paterson "teach that all aspects of the claimed invention [are] individually known in the art", it is submitted that such a conclusion "is not sufficient to establish a *prima facie* case of obviousness" because there is no *objective* reason on the record to combine the teachings of the cited prior art. In contrast, Crisp and Paterson are completely silent as to suggesting the *combination* of changing a responding method based on the condition of *both* the flip-lid *and* the plug.

It is submitted that patentable subject matter typically arises from using *known* elements in novel *combinations*. Accordingly, the Examiner's allegation that changing a responding method based on the condition of the flip-lid OR the plug is well-known *separately* is irrelevant to the determination of patentability for the *combination* thereof. At best, the Examiner has attempted to show only that the elements (i.e., flip-lid and plug) of the claimed invention are *individually* known without providing a *prima facie* showing of obviousness that the *combination* of elements recited in the claims is known or suggested in the art.

Based on all the foregoing, it is submitted that claims 3 and 11 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection of claims 3 and 11 under 35 U.S.C. § 103 over Crisp in view of Kim and Paterson be withdrawn.

**V. CLAIMS 4, 5, 12 AND 13 ARE PATENTABLE OVER CRISP IN VIEW OF PHILLIPS AND PATERSON**

Claims 4 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crisp in view of Phillips and Paterson, and claims 5 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Crisp in view of Paterson and Phillips. These rejections are respectfully

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traversed for reasons similar to those discussed above with respect to claims 2 and 10 regarding the antenna. Further, similarly to claims 3 and 11, claims 4, 5, 12 and 13 each embody functionally interrelated detecting circuits in *combination* whereas the proposed combinations merely, at best, suggest that the circuits are *individually* known.

Based on all the foregoing, it is submitted that claims 4, 5, 12 and 13 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection of claims 4, 5, 12 and 13 under 35 U.S.C. § 103 over Crisp in view of Phillips/Paterson be withdrawn.

#### VI. CLAIMS 6 AND 14-16 ARE PATENTABLE OVER CRISP IN VIEW OF PHILLIPS AND PATERSON

Claims 6 and 14-16 stand rejected under 35 U.S.C. § 103 over Crisp in view of Kim and Ulveland. This rejection is respectfully traversed for the following reasons.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 1-5 and 9-13 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

For example, claim 16 is independently patentable for reasons similar to those discussed above with respect to claim 8. Further, with respect to claims 6 and 14, it is respectfully submitted that the proposed combination does not disclose the timer/process recited therein. The Examiner reads the answer delay time taught by Ulveland for previewing a call before answering it, as equivalent to the timer/process recited in claims 6 and 14. However, the timer/process of the present invention can *release* the *changed* responding method so as to enable, for example, return to the original responding method. Accordingly, the present invention can allow the default responding method to be automatically reset after it was changed in response to the detected result (e.g., flip-lid, antenna, etc.).

In contrast, Ulveland simply discloses providing a delay *before activating* an original responding method (which has never been changed or released). The delay of Ulveland thereby serves to pause the response rather than change the responding method. As such, it is respectfully submitted that the time delay of Ulveland is unrelated to the timer/process of the present invention. Accordingly, even assuming *arguendo* proper, it is respectfully submitted the proposed combination does not disclose or suggest the combination recited in claims 6 and 14.



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Based on all the foregoing, it is submitted that claims 6 and 14-16 are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection of claims 6 and 14-16 under 35 U.S.C. § 103 over Crisp in view of Kim and Ulveland be withdrawn.

### CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY

 # 46.692  
Michael E. Fogarty  
Registration No. 36,139

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
(202) 756-8000 MEF:MWE  
Facsimile: (202) 756-8087  
Date: May 17, 2004